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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.           | CONFIRMATION NO. |
|--|-------------|----------------------|-------------------------------|------------------|
| 09/776,454   | 02/02/2001  | Gregorio del Val     | 2001-0705                     | 9327             |
| 20872  | 7590        | 05/17/2005           | EXAMINER<br>WHITEMAN, BRIAN A |                  |
| MORRISON & FOERSTER LLP<br>425 MARKET STREET<br>SAN FRANCISCO, CA 94105-2482 |             |                      | ART UNIT                      | PAPER NUMBER     |

1635

DATE MAILED: 05/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                               |                            |  |
|------------------------------|-------------------------------|----------------------------|--|
| <b>Office Action Summary</b> | Application No.<br>09/776,454 | Applicant(s)<br>VAL ET AL. |  |
|                              | Examiner<br>Brian Whiteman    | Art Unit<br>1635           |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 18 February 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 4, 6-8, 10, 12, 22, 23, 25, 27-33, 35 and 37-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1, 2, 4, 6, 7, 12, 22, 23, 25, 27, 28, 31-33, 35, 37, 38 and 41 is/are allowed.
- 6) ☒ Claim(s) 8, 10, 29, 30, 39 and 40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/3/03</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Non-Final Rejection***

Applicant's traversal, the cancellation of claims 3, 24, and 34, and the amendment to claims 1, 2, 8, 22, 23, 29, 32, 33 and 39 filed on 2/18/05 is acknowledged and considered.

Claims 1, 2, 4, 6, 7, 8, 10, 12, 22, 23, 25, 27-33, 35, and 37-41 are pending.

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/18/05 has been entered.

### ***Information Disclosure Statement***

The IDS filed on 12/3/03 was considered and signed by the examiner and mailed on 5/14/04 with the office action. However, upon further review of the IDS filed on 12/3/03, the examiner did not initial the International Search Report (ISR) on the IDS filed on 12/3/03 or acknowledged in a prior office action if the ISR was considered. The international search report (ISR) listed on the IDS filed on 12/3/03 has been considered by the examiner, but crossed out on the 1449 because the ISR is not considered a published document. Thus, if the instant application is allowed the ISR will not be listed on the face of the patent.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 8, 10, 29, 30, and 39-40 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The limitation 'challenging the first atopic dog with the heterologous protein in purified form' in amended claims 8, 29, and 39 and claims dependent therefrom is not supported by the as-filed specification. Applicant has not pointed out where the amended claim is supported, nor does there appear to be a written description of the claim limitation 'challenging the first atopic dog with the heterologous protein in purified form' in the application as filed. See MPEP § 2163.06. Original claim 8 was directed to the claimed method further comprising repeating step (c) with the heterologous protein in purified form, when a potential allergen is identified in step (e). This would indicate that an unchallenged atopic dog (atopic dog that was not previously exposed to the first or second extract) is used in this step and not the first atopic dog. The examiner has thoroughly searched the instant specification and cannot find support for the amended claims.

### ***Response to Arguments***

Applicant's arguments, see page 10, filed 2/18/05, with respect to the rejection(s) of claim(s) 1-4, 6-8, 10, 12, 22-25, 27-35, and 37-47 under 112 first paragraph have been fully

considered and are persuasive. Therefore, the rejection has been withdrawn because of the amendment of the claims and the cancellation of claims 3, 24, and 34. However, upon further consideration, a new ground(s) of rejection is made in view of the amendment to claims 8, 29, and 39.

Applicant's arguments, see page 11, filed 2/18/05, with respect to the rejection(s) of claim(s) 1-4, 6-8, 10, 12, 22-25, 27-35, and 37-47 under 112 second paragraph have been fully considered and are persuasive because of the amendment to claims 1, 22, and 32.

### *Conclusion*

Claims 1, 2, 4, 6, 7, 12, 22, 23, 25, 27, 28, 31-33, 35, 37, 38, and 41 are in condition for allowance because the claims are free of the prior art of record.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Whiteman whose telephone number is (571) 272-0764. The examiner can normally be reached on Monday through Friday from 7:00 to 4:00 (Eastern Standard Time), with alternating Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang, acting SPE – Art Unit 1635, can be reached at (571) 272-0811.

Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center number is (703) 872-9306.

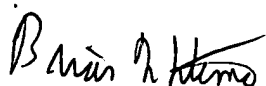
Art Unit: 1635

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

Brian Whiteman  
Patent Examiner, Group 1635

A handwritten signature in black ink, appearing to read "Brian Whiteman", is written below the printed name.